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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/665,763	09/20/2000	Timothy Dierks	06944.0029	8671

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
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EXAMINER

ZIA, MOSSADEQ

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 03/11/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/665,763

Applicant(s)

DIERKS, TIMOTHY

Examiner

Mossadeq Zia

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No. 5781723 Yee et al. in view of Patent No. 6233577 Ramasubramani et al.

3. Regarding claims 1, 7, Yee et al. shows a computer system for establishing a certificate for use in the validation of a request sent between a pair of correspondents on a public key infrastructure, the system comprising:

a secure token (smart card, Yee, col. 6, line 18) in communication with said application, said secure token including a validation engine, a cryptographic engine (Yee, col. 6, line 20-21), a certificate (Yee, col. 2, line 40-42), and a private key (device class tag, Yee, col. 2, line 44); and

a certificate authority (Yee, col. 2, line 57);

wherein said, authenticates the validity of said request through said certificate authority (Yee, col. 2, line 57-58), said certificate is signed by said cryptographic engine using said private key (Yee, col. 2, line 51-52),.

But fail to show

secure token receives said request from said application;

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an application located at one of said correspondents (hand held device), said application generating a request.

said signed certificate is sent to a correspondent, where said certificate is known to be valid by said receiving node;

However, Ramasubramani et al. teach a certificate manager module [CMM] (secure token) for a mobile device (Ramasubramani, col. 7, line 37-38) where a certificate request signal is sent to the CMM. The CMM then fetches the needed certificates from the certificate database (CA) and assigns the certificates to the particular account (Ramasubramani, col. 7, line 43-45);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Yee et al. as per teaching of Ramasubramani et al. to include a CMM to minimize latency of obtaining a certificate with a mobile device (Ramasubramani, col. 7, line 36).

4. Regarding claim 2, Yee and Ramasubramani show computer system of claim 1, wherein said validation engine is invoked on each request to utilize said private key of said secure token (Ramasubramani, col. 11, line 31-34).

5. Regarding claim 3, 8, Yee and Ramasubramani show the computer system of claim 1, 7 above, and further shows said certificate includes a certificate extension as a mechanism to indicate to said receiving node that said certificate is known to be valid (Ramasubramani, col. 12, line 17-21).

6. Regarding claims 4, 9, Yee and Ramasubramani show the computer system of claim 1, 7 above, and further shows wherein said secure token further includes a secure key (device ID), wherein said secure key is used to attest to the validity of said private key within said secure

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token and said private key is controlled by said validation engine each within said secure token (Ramasubramani, col. 13, line 57-58, 62-65).

7. Regarding claim 5, Yee and Ramasubramani shows the computer system of claim 1 above, and further show wherein said validation engine enables the system to ensure said private key within said secure token is conformant with a specified policy (Yee, col. 3, line 27-28).


8. Regarding claim 6, Yee and Ramasubramani show the computer system of claim 1 above, and further shows wherein the; validity of said certificate controls the use of said private key (Yee, col. 3, line 5-7, 9-12).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mossadeq Zia whose telephone number is 703-305-8425. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse can be reached on 703-308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

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Examiner
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